

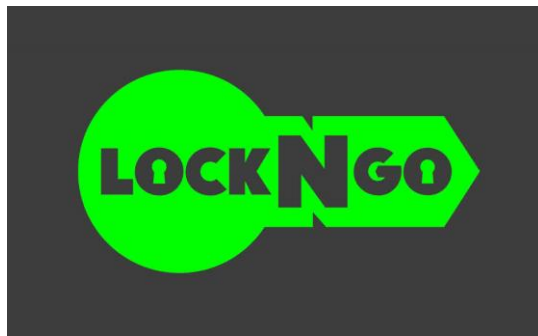
O/0390/26

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3901846

BY BUX & CO. LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:



IN CLASS 39

-AND-

THE OPPOSITION THERETO UNDER No. 442747

BY LOK'N STORE LIMITED

Background and pleadings

1. On 18 April 2023, Bux & Co. Limited (“the Applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 30 June 2023. Registration is sought for the following services:

Class 39: Providing self-storage facilities for others.

2. On 29 August 2023, Lok’n Store Limited (“the Opponent”) opposed the application under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹ For both grounds, the Opponent relies on its UK trade mark registration number 2340185, which consists of a series of three marks registered in respect of goods and services in Classes 16, 17 and 39. However, reliance is only placed on the Class 39 services. Further details of this registration are set out below:

The series:

Mark 1:

LOK’nSTORE

Mark 2:

Lok’nStore

Mark 3:

LOK’NSTORE

Filing Date: 8 August 2003

Registration Date: 30 July 2004

Class 39: Storage services; rental of storage space; packaging of goods; transportation and delivery of goods; rental of secure storage facilities.

3. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

4. Under the section 5(2)(b) ground, the Opponent claims that the competing marks are similar and that the respective goods and services are similar, giving rise to a

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

likelihood of confusion. It also claims that the distinctive character of its mark has been enhanced as a result of the use made of it.

5. Under the section 5(3) ground, the Opponent claims the marks are similar and that the earlier mark has acquired a reputation for the Class 39 services underlined in paragraph 2 above, which it claims are identical to the applied-for services. The Opponent argues that use of the contested mark would, without due cause, take unfair advantage of the reputation of the Opponent's registration and/or be detrimental to the distinctive character or reputation of the Opponent's registration.

6. As the earlier mark had been registered for more than five years at the filing date of the contested application, it is subject to the use conditions pursuant to section 6A of the Act. Accordingly, the Opponent made a statement that it has used its mark in relation to all the Class 39 services on which it relies.

7. The Applicant filed a counterstatement denying any likelihood of confusion under the section 5(2)(b) ground; and it also denies all claims of unfair advantage and detriment under the section 5(3) ground. It requested that the Opponent prove use of its earlier trade mark and the claimed reputation. In its counterstatement, the Applicant admits the competing services are identical² but denies similarity of the marks.³

8. The Applicant submits that 'LOCK N GO' has no inherent distinctiveness for self-storage services, as it is descriptive of a necessary feature of those services (namely security). With regard to the distinctiveness of the earlier mark the Applicant argues that the words in the earlier mark have little distinctiveness for self-storage services, consequently consumers would see the stylised design, not the wording, as the mark's main distinctive feature.⁴ It submits that the distinctiveness of the contested mark lies in its device elements and the colour in which it has been used, thus rendering the contested mark distinguishable from the earlier mark when both are viewed as a whole. It also criticises the Opponent's similarity assessment submitting that it relies on an artificial dissection focusing only on the competing LOK'N and LOCK N elements, whereas the marks should be considered in their entirety.⁵

² Form TM8 'Defence and Counterstatement', paragraph 16 of the counterstatement.

³ Ibid., paragraphs 16 and 20.

⁴ Applicant's submissions in lieu dated 23 August 2024, paragraph 37.

⁵ Ibid., paragraph 15.

9. Neither party elected to file submissions during the evidence rounds, but both parties filed evidence with the Opponent electing not to file evidence in reply. Neither party requested a hearing, however both filed submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

10. The Opponent is represented by Marks & Clerk LLP and the Applicant is represented by Wilson Gunn.

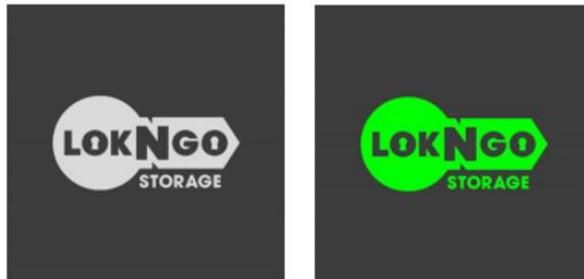
EVIDENCE FILED

Opponents' evidence

11. The Opponent filed two witness statements in chief as follows:

- (1) Neil Newman-Shepherd's witness statement dated 6 March 2024, with accompanying exhibits NS1 – NS15. Mr Newman-Shepherd is the Group Managing Director of the Opponent. His evidence is provided to support the Opponent's statement of use and claimed reputation. He states that his evidence demonstrates that the Opponent has "*extensively*" used the earlier mark "*in the UK in relation to storage services, rental of storage space and rental of secure storage facilities, and continues to do so. Consequently, the LOK'NSTORE brand has also gained widespread recognition and a reputation in the UK*" (my underlining clarifies that the identified services are those for which reputation is claimed under the section 5(3) ground).
- (2) Marcela Carvalho's witness statement dated 11 March 2024 with accompanying exhibit MC1. Ms Carvalho, a Chartered Trade Mark Attorney and Associate at the Opponent's representative firm, provides extracts from a prior first instance decision of this Tribunal involving the same parties: *Lock'N Store Limited v Bux & Co. Limited*, BL O/0025/23 (whilst MC1 contains only selected pages, I have read the decision in its entirety and emphasise from the outset that I am not bound by any of its findings). For the sake of clarity, I note that in that prior case, the Opponent opposed an application for a series of marks (shown below) that notably featured the wording 'LOK N GO', rather than 'LOCK N GO' as seen in the present proceedings. Additionally, the marks in the earlier case included the word 'STORAGE'. The opposed services were identical to those at issue in the

current proceedings. The grounds of opposition relied upon were sections 5(2)(b) and 5(3) of the Act, with the Opponent citing the same earlier right as it does in the present matter. The Opponent succeeded on both grounds, resulting in the refusal of the series application.



Applicant's evidence

12. This is provided in the witness statement of Yousuf Ayyub Bux dated 13 May 2024, with accompanying exhibits labelled Exhibit 1 – Exhibit 14 (hereinafter referred to as exhibits YAB1–YAB14 for clarity). These exhibits include:

- (1) the Applicant's company registration details (YAB1);
 - (2) the contested trade mark application certificate of filing (YAB2);
 - (3) undated screenshots from the websites of third party businesses offering self-storage services in the UK under the signs shown below (YAB3 – YAB10).
- Based on this evidence Mr Bux states that *“several competitors use different spelling variations of the word ‘lock’ and abbreviations of the word ‘and’.”*⁶



⁶ Witness statement of Mr Bux, paragraph 12.

(4) correspondence from the Registry (YAB14) in respect of the Applicant’s trade mark application for the word-only mark ‘LOCK N GO’ (application number 3901844, covering the same Class 39 services as the contested application and filed on the same day as the contested application i.e. 18 April 2023). The correspondence comprises the Registry’s examination report, which raised absolute grounds for refusal under sections 3(1)(b) and (c) of the Act (stating that the sign is descriptive and non-distinctive) followed by a letter from the Registry confirming refusal of the application (by default) due to non-response from the Applicant, with an option for the Applicant to challenge that decision.⁷

13. The remaining exhibits (YAB12 and YAB13) are intended to support Mr Bux’s assertion that self-storage providers commonly use colour as a means of distinguishing their services from those of competitors. He states that all such self-storage businesses (including the Opponent’s) “*use different colour schemes to differentiate them from each other*”⁸. Exhibit YAB12 contains screenshots from a Netherlands-based firm which, according to Mr Bux’s statement offers its services to UK-based self-storage service providers. He points out that the firm designs and constructs storage units for third parties, offering its customers the option to choose which colours they want for their units. Exhibit YAB13 comprises a collection of images of the signage of various storage businesses such as ‘Fox Self Storage’; ‘Safestore Self Storage’; ‘Access Self Storage’; ‘Shurgard Self-Storage’; ‘Pickfords Self Store’; ‘The Big Yellow Self Storage Company’ etc. (images of some of these are included below):



14. Mr Bux concludes his witness statement with the following remark at [18]: “*the combination of the unique colour scheme and the word elements and the overall*

⁷ The Registry’s records show that the decision was not challenged.

⁸ Witness statement of Mr Bux, paragraph 13.

stylisation of the [contested] Mark, make the LOCK N GO Logo easily distinguishable within the context of the self-storage industry.”

15. I shall refer to the parties' evidence where necessary in my decision.

DECISION

PROOF OF USE

16. I will begin by assessing whether the earlier mark has been put to genuine use, as the use conditions pursuant to section 6A of the Act apply equally to a claim under section 5(2)(b) as they do to a claim under section 5(3).

Proof of use legislation

17. The relevant statutory provisions are as follows:

Section 6A

- (1) This section applies where—
 - (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.
- (1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
 - (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

- (4) For these purposes—
- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

Section 100⁹

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Proof of use case law

18. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*¹⁰ as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse*

⁹ Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C-721/18, at paragraphs 73 to 83.

¹⁰ [2023] EWCA Civ 1247.

[EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

“106. [...] the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at

[22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

19. The genuine use provision is not there to assess economic success or large-scale commercial use.¹¹ An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹²

20. Therefore, the Opponent can rely on its earlier trade mark only to the extent that the evidence filed establishes that the earlier trade mark had been put to genuine use in respect of the services for which it is registered, within the five years leading up to the date on which the contested trade mark application was filed. The relevant period in which the Opponent must establish use of the earlier mark is therefore **19 April 2018 to 18 April 2023**.

Opponent's Evidence

21. I note the following from the evidence of Mr Newman-Shepherd:

(1) According to his narrative evidence, the Opponent was one of the first providers of self-storage services in the UK, having opened its first store in 1995.

(2) By August 2003 (i.e. the time the Opponent filed for its trade mark on which it relies), it had already opened 14 stores. Over the following 20 years, between

¹¹ MFE Marienfelde GmbH v OHIM, Case T-334/01.

¹² New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-415/09, paragraph 53.

August 2003 and February 2023, the Opponent opened more than 30 additional stores across various UK locations under the LOK'N STORE brand. The locations of these stores and their respective opening dates are included in Exhibit NS1.

(3) An overview of the business is included in its 2019 financial report which includes the following store location map and information:¹³



(4) He notes that the Opponent uses prominent signage on its stores and roadside signs to ensure visibility to motorists, providing numerous examples, I have included a few below (I note that all images show the LOK' N STORE brand either in blue and white or just white, on an orange background, as in the examples below):¹⁴



¹³ Exhibit NS12, pages 15 - 16.

¹⁴ Exhibit NS3.

(5) A 2018 press article featuring the image below of a new store in Wellingborough, describes the Opponent's stores as "eye-catching",¹⁵ and has the following to say about the new store:

"The wait is finally over for those people wondering what business is behind the bright orange landmark building next to Tesco in Wellingborough. [...] The centre, with its bright orange livery, [...] offers local household and business customers a low cost, secure self-storage option."



(6) A further press article announcing the arrival of a new store in 2019 describes the store's appearance in these terms: *"The eye-catching self-storage base is bright orange and positioned next to the existing John Lewis and Waitrose store"*.

(7) Referring to the press articles, Mr Newman-Shepherd highlights the significance of the Opponent's stores' distinctive and highly visible appearance, noting that they prominently display the 'LOK'nSTORE' logo.¹⁶ Accordingly, he emphasises that impactful store signage plays an important role in the Opponent's marketing campaign,¹⁷ particularly given the limited use of mass media advertising within the self-storage sector, a fact supported by a 2021 industry report.¹⁸ The report found that 70% of customers selected a storage facility based on its roadside visibility, while only 12% relied on word of mouth recommendations.

(8) In the same vein, regarding marketing, the Opponent's annual reports from 2018 and 2023,¹⁹ state: *"Store visibility remains pivotal to our marketing efforts."*

¹⁵ Exhibit NS4, page 2.

¹⁶ Witness statement of Mr Newman-Shepherd, paragraph 6.

¹⁷ Witness statement of Mr Newman-Shepherd, paragraph 7 and accompanying Exhibit NS5.

¹⁸ Exhibit NS3, page 20.

¹⁹ Provided in Exhibit NS12.

Our new landmark stores are located in highly prominent locations and we continually invest in new signage and lighting at our existing stores". The marketing segments of the reports further indicate that "Lok'nStore" attracts customers by three key drivers, namely "distinctive landmark stores", "Google and other search engines", and "existing or previous customers and customer referrals". And that the internet is the main media channel for its advertising. In the 2018/2019 financial year, £14 million was invested by the group in new store development;²⁰ and between 2022/2023, £17.3 million was invested in new stores.²¹

(9) A clear indication of marketing spend has not been provided in the financial reports, however narrative evidence confirms that the "total advertising and marketing expenditure relating to the LOK'NSTORE mark from April 2018 to April 2023 was around £3M[illion]."²² Furthermore, I note that in a 2020 self-storage industry report by the 'Self Storage Association UK' (prepared using data contributed by its members, including Lok'n Store Ltd),²³ it was reported that self-storage businesses spend 8% of their operating costs on online marketing and 3% on other forms of marketing.²⁴

(10) Exhibit NS7 contains a selection of advertising materials, including a promotional brochure and various leaflets, which Mr Newman-Shepherd states were distributed both by email and in-store. However, the extent and frequency of their distribution are not detailed. The only item with a specific date is a July 2019 advertisement in The Cove Times, promoting the Opponent's Farnborough storage centre. The rest of the materials are undated, but narrative evidence confirms that leaflets for the Cardiff and Exeter store openings are from 2019.²⁵ The leaflets and published advertisement display the following sign:



²⁰ Exhibit NS12, page 20.

²¹ Ibid., page 64.

²² Witness statement of Mr Newman-Shepherd, paragraph 11.

²³ Exhibit NS14.

²⁴ Other operating costs include staff costs, rates and taxes – those three were reported to take up a significant proportion of the total operating costs of self-storage businesses.

²⁵ Which is corroborated by Exhibit NS1 which lists the store opening dates.

(11) The promotional brochure,²⁶ though undated, lists the Opponent's store locations.²⁷ Cross-referencing with other evidence (such as the store opening dates and news articles announcing new store openings²⁸) makes it possible to infer that the brochure likely predates 2018, as it omits the Wellingborough store (opened 2018), and likely predates 2012 since the Crawley store (opened 2012) is also absent from the list, while the Harlow store (opened 2009) is included. Thus, it is reasonable to conclude it was produced before the relevant five-year use period. Nevertheless, the brochure demonstrates the Opponent's historic promotion of its self-storage services, the sale of packaging materials, and van hire using the 'LOK'nSTORE' sign. The sign appears throughout in plain text (as Lok'nStore), as well as in the following format:



(12) Exhibit NS6 contains screenshots of the Opponent's website, spanning August 2018 to April 2023. These images show use of the sign both in plain text (as Lok'nStore),²⁹ and in the variation below.



(13) The website clearly advertises secure, locked self-storage facilities, offering flexible arrangements from as little as one week to as long as required. It states that *"households, businesses, entrepreneurs, collectors, new families, downsizers, [and] jet-setting world explorers all need self-storage,"*³⁰ giving examples such as freeing up space at home, decluttering before a house sale, or storing possessions when going abroad. One reviewer similarly explains that, after completing a long cruise and continuing their travels, they did not wish to carry all their bags, so they used the Opponent's services to store two large pieces of luggage for approximately one month.³¹

²⁶ Pages 2 – 7 of Exhibit NS7.

²⁷ Exhibit NS7, page 7.

²⁸ Exhibit NS4.

²⁹ See by way of example, Exhibit NS6, page 7.

³⁰ Exhibit NS6, page 11.

³¹ Exhibit NS8 page 13.

(14) Extracts from the annual reports for 2018 to 2023 – prepared using the audited financial statements of Lok’nStore Group Plc (the ‘parent company’) and its subsidiaries (the ‘group’)³² show the reported group revenue – the parent company has been listed on AIM since June 2000.³³ Mr Newman-Shepherd has provided the table transcribing the revenue figures as follows:

Year	2018	2019	2020	2021	2022	2023*
Revenue	£17.75m	£17m	£18m	£21.9m	£22.57m	£25.30m

*information up until July 2023

(15) Each annual report lists both total group revenue and revenue from self-storage alone. I note that the group revenue table above contains a few discrepancies when read in conjunction with the financial statements exhibited,³⁴ likely due to a conflation of the two revenue figures. For clarity, I note that the financial statements report *self-storage revenue* up to July 2023 as follows:

Year	2018 ³⁵	2019 ³⁶	2020 ³⁷	2021 ³⁸	2022 ³⁹	2023 ⁴⁰
Self-storage Revenue	£14.78m	£16.0m	£17.0m	£20.6m	£22.57m	£25.3m

(16) A selection of invoices dated within the relevant period are provided.⁴¹ The invoices are issued by the Opponent, Lok’nStore Limited, for storage services, rental of storage units, insurance cover and sale of padlocks. The letterhead of each invoice displays the sign below on the left (up to and including 2020) and the one below on the right (from 2021 onwards):



³² Each report contained in Exhibit NS12 defines ‘Lok’nStore Group Plc’ as the ‘parent company’, and its subsidiaries as the ‘group’ – see by way of example page 10 of the exhibit.

³³ Exhibit NS11, page 2. I note that AIM is the Alternative Investment Market of the London Stock Exchange.

³⁴ Namely, the 2022 group revenue was £26.9 million rather than £22.57 million (the latter being the self-storage revenue only); in 2023 the group revenue reported was £27.1 million and the self-storage only revenue was £25.3 million.

³⁵ Exhibit NS12, page 5.

³⁶ Ibid., page 19.

³⁷ Ibid., page 43.

³⁸ Ibid., page 43.

³⁹ Ibid., page 61.

⁴⁰ Ibid., page 66.

⁴¹ Exhibit NS10.

(17) The annual reports include a segment on ‘ancillary sales’, comprising “*boxes and packaging materials, insurance, and other sales*”. These consistently account for around 11% of reported self-storage revenues; for example, in 2023, ancillary sales represented 10.8% of revenue, equivalent to £2.49 million.

(18) The annual reports also detail year-on-year that the majority of the self-storage revenue derives from household customers and the remainder of the self-storage revenue is from business customers. In 2019, its total customers were in excess of 11,800,⁴² and in 2020 the total was 16,100.⁴³

(19) With regard to market size, the ‘Self Storage Association UK’ reported in 2020 that there were 1015 self-storage brands owning a total of 2050 stores, and that the annual turnover of the industry was £930 million;⁴⁴ by 2023 there were 1086 brands, owning a total of 2231 stores, with an annual industry turnover of £990 million. The Opponent was ranked the fifth largest UK organisation (by number of stores) in the 2020, 2022 and 2023 industry reports prepared by the ‘Self Storage Association UK’.⁴⁵ An article published by the ‘Investors’ Chronicle’ in October 2022, reports that Lock’n Store Group plc was one of the leading risers on AIM and that its market value was £279 million.⁴⁶

(20) In 2018, the Opponent was a finalist in the ‘Self Storage Association UK’ awards for ‘Best Major Self Storage Facility’.⁴⁷ From 2018 to 2023, the Opponent was consistently rated highly on the customer review platforms of ‘Google Reviews’, ‘Trustpilot’ and ‘Feefo’, obtaining many five star customer ratings and high average score ratings in excess of 4.5 (out of 5),⁴⁸ with one customer in 2018 stating they have been using “*Lok’nStore on and off for 15 years and [...] wouldn’t go anywhere else*”.⁴⁹

(21) Mr Newman-Shepherd concludes by stating that he believes his evidence demonstrates that the Opponent has made extensive use of the earlier mark in the UK for storage services, rental of storage space and rental of secure storage

⁴² Ibid., page 16.

⁴³ Ibid., page 41. I note that customer totals are not provided for other financial years during the relevant period.

⁴⁴ Exhibit NS14, page 13.

⁴⁵ Exhibit NS14.

⁴⁶ Exhibit NS9, page 31.

⁴⁷ Exhibit NS15.

⁴⁸ Exhibit NS8 and NS8B.

⁴⁹ Exhibit NS8, page 10.

facilities, resulting in widespread recognition and a reputation in the UK. He asserts that the reputation is attributed to years of investment and consistently high service standards offered under the mark.

Form of the mark

22. Section 6A(4)(a) of the Act provides that use of a trade mark includes use in a variant form that differs from the registered mark only in elements which do not alter its distinctive character. The purpose of the provision is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.⁵⁰ Where the sign used in trade differs only in negligible elements, the two forms can be regarded as broadly equivalent, and proof of use of the variant form satisfies the use requirement.⁵¹

23. The approach to assessing use in a 'variant form' is to compare the form used with the registered form. The comparison focuses on identifying any added or subtracted elements that could alter distinctive character, noting that changes to figurative elements are usually less likely to change the distinctive character than those related to the word elements; and the addition of descriptive or suggestive words is unlikely to change the distinctive character of the mark.⁵²

24. For word marks, protection covers the words themselves, not any particular presentation of the words, therefore the font in which a word mark might be represented must not be taken into account; a word mark may be used in any form, in any colour or font type;⁵³ and registration of a mark in black and white covers its use in colour.⁵⁴ Greyscale marks are subject to the same principles of use as black and white marks; moreover, they require that the same contrast of shades is respected –

⁵⁰ See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

⁵¹ *Ibid.*

⁵² See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, paragraph 13.

⁵³ *La Superquímica v EUIPO*, T-24/17 at [39].

⁵⁴ See *Specsavers* [2014] EWCA Civ 1294 at [5]; and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015] EWCA Civ 290, at [47].

preserving this contrast ensures that the mark's overall impression remains consistent with the registered representation.

25. Under section 41(2) of the Act, as clarified in *Comic Enterprises Ltd v Twentieth Century Fox Film Corpn*,⁵⁵ to be accepted for registration as part of a series, series marks must share the same essential features and differ only in minor, non-distinctive details so their overall identity remains substantially the same from the perspective of the average consumer. It logically follows that because they are registered as a series, each mark in the series relied on is therefore equivalent because they resemble each other in their material particulars. Furnishing evidence of use of any mark in the series constitutes use on which the Opponent can rely.

26. The earlier series mark is shown below, it comprises of: two word-only marks (Marks 2 and 3), one in capitals and the other in initial capitals, both neutral as to the form in which they may be used; and one stylised word mark (Mark 1) in greyscale, which is restricted to its registered font but not to any specific colourway.

Mark 1:

LOK'nSTORE

Mark 2:

Lok'nStore

Mark 3:

LOK'NSTORE

27. The evidence shows that the Opponent uses the following signs:

(1) Lok'nStore

(2) **Lok'nStore**

(3) **LOK'nSTORE**

⁵⁵ [2016] Bus. L.R. 849 at [58].



28. Taking all the foregoing into account, it is clear that signs (1), (2) and (3) listed above are examples of use of the series mark as registered, either because they are identical to the registration or because they fall within its notional and fair use. Therefore use of these signs is use upon which the Opponent can rely.

29. With regard to signs (4), (5) and (6) listed above, the addition of the words 'self-storage' and 'storage' below a dividing line, do not alter the distinctive character of the earlier mark. Although these signs display the LOK'n element above STORE, this arrangement does not prevent the sign from being perceived as LOK'n STORE. These signs are therefore acceptable variants of the earlier mark, and use of these signs constitutes use upon which the Opponent can rely.

Conclusions on the proof of use evidence

30. Although the Opponent's operations are primarily concentrated in the South-East of the UK, the evidence shows that during the relevant period it was reported as the fifth largest self-storage organisation in the UK by number of stores, which is significant when bearing in mind that when that data was collected, there were circa 1,000 operators of self-storage businesses in the UK.

31. The self-storage industry's yearly turnover exceeded £900 million, generated by over 1,000 operators. The revenue reported by the Opponent therefore represents a notable share of the overall market.

32. While there are some deficiencies in the examples of marketing materials provided, I am satisfied that a proportion of these relate to the relevant period and bear the earlier mark or an acceptable variant thereof. Although the evidence shows that self-storage providers typically allocate only a small proportion of operating costs to marketing, the Opponent's marketing spend of £3 million over the five-year period appears quite significant. Furthermore, the Opponent's focus on store visibility and significant continued investment in new stores during the period are indicative of a growing business, as reflected in its year-on-year revenue increases.

33. The Opponent has provided sufficient evidence to establish that it has made genuine use of the earlier mark within the self-storage industry. The evidence demonstrates that the Opponent has consistently offered self-storage services, including the rental of storage space under the mark, and that its presence in the industry has been continuous throughout the relevant five-year period. The Opponent may therefore rely on the registered terms: "*storage services; rental of storage space; rental of secure storage facilities.*"

34. With regard to "*packaging of goods*", while the evidence supports a finding that the Opponent sells packaging materials, there is no evidence that it provides packaging services for customers. The Opponent therefore cannot rely on this term.

35. Similarly, although there is scant evidence that the Opponent offered van hire, this does not amount to providing "*transportation and delivery of goods*", and in any event, that evidence predates the relevant period. The Opponent cannot rely on this term.

Claim under section 5(2)(b)

Legislation and Case Law

36. Section 5(2)(b) of the Act states:

"5(2) A trade mark shall not be registered if because-
[...]
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade (mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

37. I am guided by the principles applicable to the assessment of the likelihood of confusion, as cited with approval by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25. These principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market ("OHIM")*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of services

38. The Applicant’s services and the services which the Opponent may rely on are set out below:

Opponent’s services	Applicant’s services
<u>Class 39:</u> Storage services; rental of storage space; rental of secure storage facilities.	<u>Class 39:</u> Providing self-storage facilities for others.

39. The Applicant has expressly stated that it “does not contest that the services offered by both parties are identical.”⁵⁶ I therefore proceed on the basis of this concession.

The average consumer and the nature of the purchasing process

40. Trade mark questions, including the likelihood of confusion, must be viewed through the eyes of the average consumer of the goods and services in question. It is therefore necessary to determine who the average consumer of the services is, and

⁵⁶ Applicant’s submissions in lieu dated 23 August 2024.

how the consumer is likely to select them. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. The word 'average' merely denotes that the person is typical,⁵⁷ which in substance means that they are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics.⁵⁸

41. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, at [15]-[20], where he pointed out the following in relation to the average consumer:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

⁵⁷ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), paragraph 60

⁵⁸ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

42. The Opponent's evidence supports my view that the average consumer comprises both members of the public and businesses. Consumers are likely to encounter the marks through roadside signage, promotional materials (such as leaflets), or online. Industry analytics for the secure-storage sector indicate that consumers predominantly choose a provider simply because the facility is nearby and visible from the roadside. This not only suggests that the selection process is largely visual, but also that it is based on a relatively superficial criterion rather than any deeper assessment. As a result, the selection process is not overly scrutinised, supporting a finding that the level of attention applied is relatively low.

43. Although visual selection is the primary method, I do not rule out the possibility of an aural selection based on word-of-mouth recommendations, a conclusion that is likewise supported by the Opponent's evidence.

Comparison of marks

44. I have already set out the principles gleaned from established case law with regard to comparing competing marks. I also note that the Court of Justice of the European Union ("CJEU") stated in *Bimbo SA v OHIM*,⁵⁹ that:

"[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

⁵⁹ Case C-591/12P, at paragraph 34.

45. The marks being compared are shown below:

Earlier series mark	Contested mark
<p>Mark 1:</p> <p style="text-align: center;">LOK'nSTORE</p> <p>Mark 2:</p> <p style="text-align: center;"><u>Lok'nStore</u></p> <p>Mark 3:</p> <p style="text-align: center;">LOK'NSTORE</p>	

Opponent's submissions

46. The Opponent submits that the respected marks coincide in that LOK'N and LOCK N form the first part of the marks – that the differences on account of the apostrophe and the letter C does not prevent them from being highly similar and would make little impact on consumers. More specifically the Opponent submits that:

- (1) the marks are visually highly similar as they coincide with their first elements LOK'N and LOCK N;
- (2) the prefixes LOK'N and LOCK N would be pronounced identically rendering the marks aurally highly similar overall; and
- (3) the marks have highly similar concepts, the earlier mark alluding to the fact that the user may store something securely on the basis that it can be locked away, and the contested mark alluding to a more express type of storage service – both sharing the concept of locking and storing something away; and that this concept is reinforced in the contested mark by the presence of the figurative key and keyhole elements. The Applicant submits that, since GO has an inherently weak distinctive character, if any, and STORE has no inherent distinctive character in the context of the storage services at issue, their presence does not reduce the high degree of conceptual similarity arising from the conceptually identical initial elements of the marks.

47. The Opponent says its submissions are in line with established case law which provides that the “*consumer normally attaches more importance to the first part of the mark [...] This is justified by the fact that the public reads from left to right, which makes the part placed at the left of the sign the one that first catches the attention of the reader*” (Case T 336/03 *Mobilix*); and that where signs coincide in their initial elements, the public is highly likely to view the marks as similar since they read left to right (Case T146/06 *Sanofi-Aventis v OHIM – GD Searle*); and that “*two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects*” (Case C-3/03 *Matratzen Concord GmbH v OHIM*).

Applicant’s submissions

48. With regard to the common word elements between the respective marks, the Applicant accepts that LOCK is conceptually identical to LOK and that the single letter N will be understood as AND in both marks,⁶⁰ such that LOCK N and LOK’N will be perceived as LOCK AND.⁶¹ It also submits that “*the word LOCK, howsoever represented, may be followed by a further verb to emphasise the utility of the storage services,*”⁶² that is, whether expressed as LOCK or LOK, this word may be paired with a verb such as STORE or GO, to “*emphasise the utility of the storage services*”. In essence it argues that as LOCK N GO and LOK’N STORE are descriptive and/or non-distinctive, the distinctive character of the earlier mark resides in its stylistic elements (including its colour and overall stylisation), which it submits are different from the stylistic elements of the contested mark.

49. In support of this position, the Applicant relies on its evidence which it submits shows that businesses in the self-storage market are distinguished primarily by their overall colour schemes and visual presentation. It also relies on the examination report issued in respect of the absolute grounds objection to its word-only application for LOCK N GO,⁶³ noting that its figurative application was accepted whereas the word-only application was objected to, and on this basis it maintains that the words

⁶⁰ Applicant’s submissions in lieu, at [18]

⁶¹ *Ibid.*, at [35].

⁶² *Ibid.*, at [20].

⁶³ Filed the same day as the contested figurative mark.

LOCK N GO are descriptive and non-distinctive and cannot, on their own, function as a trade mark.⁶⁴

50. With regard to the word STORE in the earlier mark, the Applicant submits it is entirely descriptive and thus non-distinctive,⁶⁵ with regard to LOK, it submits that *“the word LOCK, howsoever represented”* (i.e., whether as LOCK or LOK) is of very low, if any, inherent distinctiveness for the relevant services,⁶⁶ relying on its evidence of competitors using variations of “lock” and abbreviations of “and”.

51. The Applicant submits that the *“Opponent’s evidence supports the visual orientation, or dominance of colour and visual aspects of trade marks, within the self-storage marketplace”*⁶⁷ and points to the evidence of Mr Newman-Shepherd which discusses the *“striking appearance”* of the Opponent’s stores and the importance of signage to attract customer attention.⁶⁸ It goes on to submit that consequently the *“recognition of the Earlier Mark by the average consumer cannot easily be dissociated from the context of its use, being the bright orange cladding contributing to the striking look and the eye-catching elements of the Earlier Mark.”*⁶⁹

52. It is the Applicant’s contention therefore that the verbal elements of the earlier mark have *“little, if any, distinctiveness”*, such that the overall stylisation of the earlier mark is its *“standalone dominant and distinctive element”*.⁷⁰

53. In other words, the Applicant submits that the dominant and distinctive elements of the competing marks lie in their colours and figurative features, and that this accords with its evidence concerning the use of colour in the self-storage industry, which it submits shows that the distinctive and distinguishing features of trade marks in that marketplace are their overall colour schemes and visual presentation.⁷¹ Those submissions appear to be directed to the proposition that, self-storage service providers are distinguished principally by visual presentation, with the trade names used for those services playing a lesser role.

⁶⁴ Applicant’s submissions in lieu, at [39].

⁶⁵ Ibid., at [36].

⁶⁶ Ibid., at [19].

⁶⁷ Ibid., at [24].

⁶⁸ Ibid.

⁶⁹ Ibid., at [32].

⁷⁰ Ibid., at [37].

⁷¹ Ibid., at [22] - [24].

54. Against that background, and as summarised at the outset of this section of my decision, the Applicant contends that, as the verbal elements LOK'N STORE and LOCK N GO are descriptive and/or non-distinctive, the distinctive character of the earlier mark resides in its stylistic elements, which it submits differ from those of the contested mark. Taken together, it is my understanding that the Applicant invites a comparison between the marks shown below, confined to their figurative and stylised elements, with no weight placed on their verbal elements:



55. I note that the examination report for the Applicant's word-only trade mark LOCK N GO, represents only a prima facie view and has not been tested or upheld on appeal, and I am not bound by it. Furthermore, the Applicant's submissions above focus on earlier Mark 1 alone and the evidence of use in the marketplace, overlooking the fact that the registration is a series, which also includes word-only marks (Marks 2 and 3). The inherent distinctiveness of word-only marks cannot be assessed by reference to stylisation. The presence of word-only variants within the series means that the word elements form an integral part of the earlier mark and must be given appropriate weight in the comparison.

56. Even in circumstances where competing marks have been registered or accepted for registration under the cover of a figurative figleaf of distinctiveness (on the basis that their verbal elements are entirely descriptive, and any distinctiveness resides in stylisation), the assessment of similarity between competing marks must not be conflated with the assessment of distinctive character or likelihood of confusion. For the avoidance of doubt, whilst it is necessary to take account of descriptive and/or non-distinctive terms in the overall assessment of the likelihood of confusion, this does not alter an assessment of the degree of similarity between the marks. By way of a simple example, differing stylisations would not prevent two marks consisting solely of the verbal element *SOAP*, registered or applied for soap, from being verbally and

aurally identical, even though that word is entirely descriptive of the goods. As stated by the General Court in *Société des produits Nestlé SA v OHIM*:⁷²

“While it is true that it is necessary to examine the distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs in order to determine any dominant element of the sign, the degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs.”

57. Importantly, distinctiveness is only one factor in the global assessment and does not determine how similar the consumer perceives the marks to be. As the CJEU stated in *L’Oréal SA v OHIM* (Case C-235/05 P) at [42] and [45], the distinctive character of the earlier mark is not a factor that influences the consumer’s perception of the similarity of the signs and should not be given undue importance, otherwise, such an approach would sideline the comparison of the signs by placing disproportionate emphasis on the weak distinctiveness of the earlier mark.

58. There is nothing in the Applicant’s evidence and submissions that persuade me to depart from the ordinary notional comparison of the marks which I am required to undertake for a claim based on section 5(2)(b) of the Act. This requires me to consider the full scope of protection conferred by registration, which is not (depending on the type of mark) necessarily limited to the precise form in which a mark is shown on the Register nor restricted to the form in which a registered mark has thus far been used on the market.

Overall impression

The Opponent’s registration

59. The Opponent’s series registration comprises three marks, each of which consists of the three letter sequence LOK, followed by an apostrophe and the letter N, forming

⁷² Joined cases T-5/08 to T-7/08, at [65]. Also see for example, *Ravensburger AG v OHIM*, Case T-243/08 at paragraph 27.

the contracted element LOK'N. This element is then followed by the ordinary word STORE.

60. The average consumer is likely to perceive LOK as a misspelling of the word LOCK, and will likely understand the apostrophe-N as a substitution of the word AND, on the basis that the word AND can be pronounced in such a way that it simply sounds like the letter N. Accordingly, the element LOK'N would be perceived as LOCK AND.

61. Marks 2 and 3 in the series are word-only marks, one presented entirely in capitals and the other in title case. As word marks, their overall impression lies in the words themselves, rather than any particular presentation of them.

62. Mark 1 in the series is a stylised word mark presented in greyscale. It is therefore not limited to use in any specific colourway. Because it is registered as part of a series comprising word-only marks, the stylised presentation of Mark 1 is regarded as a minor, non-distinctive variation. Accordingly, the material particulars of Mark 1 (the words themselves) are the same as the material particulars of Marks 2 and 3,⁷³ such that, notwithstanding it is stylised, the overall impression of Mark 1 is likewise dominated by the words.

The Application

63. The mark consists of the word elements LOCK N GO presented in a specific font. Visually, the letter N is noticeably larger than the other letters. The text appears in black against a bright green background shaped as a key device; and the key device appears on a black background. Both the O in LOCK and the O in GO incorporate keyhole-shaped cut-outs. Whilst the device elements are prominent within the mark, I consider the word elements to play a more dominant role in the overall impression, bearing in mind that the average consumer tends to be drawn to the element of a mark that can be read,⁷⁴ and that the key and keyhole motifs reinforce the message conveyed by the word LOCK.

⁷³ Section 41(2) of the Act; *Comic Enterprises Ltd v Twentieth Century Fox Film Corpn.*

⁷⁴ The 'CReMESPRESSO' case.

64. Whilst I am mindful that circumstances may arise in which some words within a mark may be omitted when a mark is spoken,⁷⁵ for example, the following signs presented in the Applicant's evidence may be "*simplified or shortened*"⁷⁶ to "Big Yellow"; "Shurgard"; "Safestore"; and "Fox" (by omitting the descriptive element 'self-storage'; and the secondary elements "the" and "company"), I do not consider that to be the case with the competing marks before me. In particular, I do not consider that the average consumer would shorten LOK'N STORE to LOK'N, nor would LOCK N GO be shortened to LOCK N. The words STORE and GO are integral parts of the competing marks and cannot be ignored in the comparison.



Visual comparison

65. I proceed with my comparison from the starting point that notionally, the earlier series registration protects the words in any font and stylisation (including as shown in Mark 1 of the series), and the earlier mark is protected in any colourway. As the Appointed Person observed in *HERNO*,⁷⁷ "*the point is that the word mark is not limited to any particular script and therefore the script or font in which the device mark is written does not provide a point of distinction in itself.*"

66. The key-shaped background and the keyhole motifs within the letters O of the contested mark represent visual points of difference.

67. Taking the foregoing into account, the marks notably coincide in the very high degree of similarity of their initial word elements: LOK'N in the earlier mark and LOCK N in the contested mark. The only notable differences between these words are the apostrophe in the earlier mark and the inclusion of the letter C in the contested mark. However, the presence or absence of an apostrophe and the letter C is likely to go unnoticed. I remind myself of the observation of Richard Arnold QC (as he then was),

⁷⁵ See *Enrich International Ltd v Onyinye Udokporo*, BL O/1141/25, in which the Appointed Person, at [13] to [18], considers the approach to spoken and unspoken elements of a trade mark.

⁷⁶ *Ibid.*, at [16].

⁷⁷ BL O/954/22 at [34].

sitting as the Appointed Person in *Kennedy Fried Chicken* (BL O/227/04 at [18]), that “*human beings have a tendency to see what they expect to see.*” Accordingly, on a quick visual scan, consumers may not notice the visual differences between LOK’N and LOCK N.

68. Further comparing the word elements, the marks differ in that LOK’N is followed by the word STORE in the earlier mark, whereas LOCK N is followed by GO in the contested mark.

69. Notwithstanding the very high degree of similarity between their initial word elements, taking account of the identified differences in the other elements making up the marks, I consider the marks to be visually similar to between a medium and high degree overall.

Aural comparison

70. LOK in the earlier mark will be pronounced as the ordinary word LOCK, and N will be pronounced as that single letter is ordinarily pronounced. Therefore, LOCK N in the contested mark will be pronounced identically to LOK’N. The words STORE and GO have differing sounds and will act as points of aural difference, rendering the marks aurally similar to a medium overall.

Conceptual comparison

71. The marks convey highly similar ideas, sharing a common “lock + action” structure – both marks invite the average consumer to ‘lock and’ do something. The Applicant submits that: “*the Later Mark entreats the average consumer to lock and go, or safely leave, their personal valuables, whereas the Earlier Mark entreats the average consumer to lock and store, or safely store, their personal valuables.*”⁷⁸ I agree with this characterisation of the marks’ concepts – within the context of the services, both marks have an underlying secure-storage concept. Whilst the Applicant’s GO element introduces a nuance of convenience and speed, suggesting a more immediate or express storage service, this operates as a refinement of the same underlying secure-

⁷⁸ Applicant’s submissions in lieu, at [26].

storage concept, rather than a departure from it. Overall, the concepts are highly similar.

Distinctive character of the earlier mark

72. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,⁷⁹ the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

73. The degree of distinctiveness of the earlier mark is one of the factors that must be taken into account when assessing whether there is a likelihood of confusion. The purpose of assessing the distinctive character is to determine how the level of distinctiveness of the earlier mark may affect the likelihood of confusion, this is because the more distinctive the earlier mark is, the greater the likelihood of confusion may be.⁸⁰

74. Whilst distinctiveness is assessed by reference to the mark as a whole, simply stating the overall level of distinctiveness of the earlier mark is not sufficient, it is the distinctive character of the component or components that are similar between the

⁷⁹ Case C-342/97.

⁸⁰ *Sabel v Puma* at [24].

marks that is of particular relevance. In this regard, the Appointed Person in *Kurt Geiger v A-List Corporate Limited*,⁸¹ using a simple example of marks with a figurative figleaf of distinctiveness to illustrate his point, stated:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.

40. To take a simple example, a device mark for the word ‘SOAP’ presented with each letter intertwined with barbed wire would have considerable distinctive character even if registered for soap. However, this distinctiveness is provided entirely by the barbed wire element in the device, not by the word SOAP which is entirely descriptive. The high distinctive character of the device would not therefore increase the likelihood of confusion in the event of someone else using the word SOAP in a trade mark for soap but presenting the letters in the form of a fish.”

75. In other words, it is necessary to determine in what the distinctive character of the earlier mark lies, so that the analysis can focus on those components that are common to, or similar between, the marks at issue. Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

76. Registered trade marks possess varying degrees of inherent distinctive character, ranging from low, because they are suggestive or allusive of a characteristic of the goods or services, to high, such as invented words which have no allusive qualities.

77. I begin by assessing the inherent distinctive character of the earlier trade mark. As previously noted, the Applicant submits that the words LOK’N STORE are descriptive and/or non-distinctive. Although not expressly pleaded, this could be perceived as a challenge to the validity of the registration (particularly when bearing in mind that it comprises word-only marks, and the inherent distinctiveness of word-only marks does not reside in their stylisation, but in the words themselves). For clarity, a challenge to the validity of the earlier registered mark cannot be made in these proceedings, and I

⁸¹ BL O-075-13

must proceed on the basis that the earlier mark is validly registered.⁸² It follows that I must also adopt the established starting point that a registered trade mark possesses at least some degree of inherent distinctiveness.⁸³

78. I have regard to the Applicant's material concerning third-party use of signs incorporating "*spelling variations of the word 'lock' and abbreviations of the word 'and'*", relied upon to demonstrate the alleged lack of distinctiveness of the components the marks have in common. Whilst I note that evidence of third-party traders using similar signs *may*, in certain circumstances, result in the distinctive character of a trade mark being assessed as weaker than might otherwise be the case,⁸⁴ the evidence presented is undated and limited in scope and therefore carries little weight. It does not establish that, at the relevant date, the inherent distinctiveness of the LOK'N element had been weakened or that consumer perception of that element (including its understanding as "lock and") had been affected. In any event, evidence of apparent coexistence does not, of itself, preclude nor undermine a finding of a likelihood of confusion).

79. The Opponent concedes that "*while the reference to 'LOCK AND STORE' [...] may not be remarkable on the services at issue*",⁸⁵ and that "*the word 'STORE' has no inherent distinctive character in the context of the storage services at issue*",⁸⁶ it maintains that its mark is nonetheless inherently distinctive and that its distinctive character "*has been deeply enhanced to a high degree due to the effort and expense expended by the Opponent to create a well-respected brand, which is associated by the UK consumer with excellent and reliable self-storage services.*"⁸⁷

80. I begin my assessment of the inherent distinctiveness of the earlier mark first.

81. The descriptive meaning of the word STORE is obvious when considered in relation to the relevant storage services. The unconventional presentation of the contracted LOK'N element offers insufficient disguise to the fact that it would be understood as LOCK AND. However, that does not mean that its unconventional

⁸² Section 72 of the Act.

⁸³ See *Formula One Licensing BV v OHIM*, Case C-196/11P.

⁸⁴ *Lifestyle Equities CV & Ors v Royal County of Berkshire Polo Club Ltd & Ors*, [2024] EWCA Civ 814, at [42] and [48] – [49].

⁸⁵ Opponent's submissions in lieu, dated 23 August 2023, at [69].

⁸⁶ *Ibid.* at [46].

⁸⁷ *Ibid.*, at [57].

presentation should be disregarded completely when assessing the inherent distinctive character of the mark, nor that the combination of LOK'N followed by the word STORE is to be treated as an ordinary or purely descriptive construction, notwithstanding that the mark conveys a clear conceptual message overall.

82. The evidence shows that the Opponent has at times used the words LOK'N STORE alongside additional wording such as "self-storage" or "storage". While those additional words are plainly descriptive of the services, their use serves to reinforce my point that the words LOK'N STORE themselves are not being deployed merely as a description of the services offered. Rather, they function as the primary badge of origin, with the additional wording providing further descriptive context. This supports my view that, although the words convey a readily understood message, they are not purely descriptive of the services and possess a degree of inherent distinctiveness.

83. Although LOK would be perceived as the ordinary word LOCK, that does not mean it describes storage services. At most, it is allusive, pointing towards a feature consumers would reasonably expect or desire of self-storage, namely that their belongings will be locked up. Further, whilst substituting the word AND with an apostrophe-N is not, in itself, especially distinctive, it is nonetheless a non-standard representation of that word and contributes to the mark's overall inherent distinctiveness. Taken together, the LOK'N element (even when perceived as "lock and") is not wording the average consumer would ordinarily use to describe the services, and therefore introduces a degree of inherent distinctiveness.

84. Although the mark conveys a readily understood conceptual message, the construction LOK'N STORE is unusual because it presents the "lock" action first, which is not the ordinary way of framing the storage process. Ordinarily, a consumer would first place their belongings into storage and then lock the unit, that is, they would "store and lock", not "lock and store". This reversal of the usual sequence of actions gives the construction a degree of peculiarity, which also contributes to its inherent distinctiveness.

85. Taking the foregoing into account, the inherent distinctive weight of the earlier mark lies in the LOK'N element, and in the atypical "lock and store" construction identified above, and the stylisation of Mark 1 adds no notable distinctiveness to the

words themselves. I therefore find that the earlier mark possesses a modest degree of inherent distinctive character, sitting between a low and medium level.

86. Turning to the assessment of enhanced distinctiveness, I note the following from the Opponent's evidence (although the Applicant criticises the distinctiveness of the earlier mark, none of this evidence is contradicted by any evidence from the Applicant):

- (1) The Opponent started using its LOK'N STORE brand in the UK in 1995 in relation to self-storage services. Whilst use of the sign pre-dates the filing date of its trade mark, the evidence still supports long-standing use of the mark through the subsequent opening of over 30 new stores since the trade mark filing date.⁸⁸
- (2) Between 2022 and 2023 alone it invested in excess of £17 million in new stores; and over a five year period it invested £3 million in marketing and advertising – its continued investment in these areas supports the picture of a business that continues to steadily grow.
- (3) With over 1,000 businesses in the UK self-storage market, the Opponent has been ranked as the fifth largest in the UK by number of stores on several occasions within the five years preceding the contested application. This ranking points to a strong market position, notwithstanding the fact that the evidence indicates that the Opponent's business activity is largely concentrated in the South-East of England.
- (4) Its customer satisfaction ratings are high and the evidence points to repeat custom; furthermore, in 2018 the Opponent's business became a finalist in the self-storage industry awards for 'Best Major Self Storage Facility'.
- (5) Revenue from self-storage operations increased each year between 2018 and 2023, totalling over £116 million across the period. Even after deducting the approximately 11% attributable to ancillary sales (such as packaging materials etc.), the resulting revenue represents a notable share of the overall self-storage market.

⁸⁸ See Exhibit NS1.

(6) The Lok'n Store Group plc, of which the Opponent forms part, had a market value of £279 million in 2022.

87. The Applicant submits that recognition of the earlier mark by the average consumer “cannot easily be dissociated from the context of its use, being the bright orange cladding contributing to the striking look and the eye-catching elements of the Earlier Mark.” I accept that the Opponent’s mark is frequently encountered in a highly distinctive and visually prominent context, and that this context has played a role in attracting consumer attention. However, that does not mean that any strengthening of the mark’s distinctive character through use is confined to that presentation alone.

88. The evidence shows that the Opponent has not confined its use of the mark to a single fixed get-up or colour scheme. Rather, the LOK’N STORE mark has been used throughout the relevant period both in plain text and in stylised form, and, while the orange colouring of the cladding on the Opponent’s stores is a consistent feature, the mark itself has been used in more than one colour presentation during the relevant period i.e. blue and white, or just white. Further, the earlier registration includes word-only marks, which may be used in any font or colour.

89. As set out above, I have assessed the earlier mark as possessing an inherent distinctive character of between a low and medium degree. I further find that the evidence is more than sufficient to demonstrate that use of the mark has substantially strengthened its distinctive character in relation to “*storage services; rental of storage space; rental of secure storage facilities*” by the relevant date. To the extent that the mark has become more distinctive through use, that enhancement is capable of attaching to the word mark itself and is not dependent on any single stylisation or colour scheme. Overall, the earlier mark has been enhanced to a high degree of distinctiveness through the use made of it.

Conclusions on the likelihood of confusion

90. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.⁸⁹ I must also consider the average consumer of the services, the nature

⁸⁹ Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V., Case C-342/97, paragraph 27

of the purchasing process and bear in mind that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa.⁹⁰

91. Making an assessment as to the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The global assessment is supposed to emulate what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark in mind. It is not a process of analysis or reasoning, but an impression or instinctive reaction.⁹¹ The relative weight of the factors is not laid down by law but is a matter of judgement for the tribunal on the particular facts of each case.⁹²

92. I bear in mind that the assessment of likelihood of confusion is forward-looking,⁹³ taking into account the notional and fair use of the marks.

93. It is well established that confusion can be direct, which is a simple matter of the consumer mistaking one mark for another, or indirect. Indirect confusion arises where the consumer recognises that one mark is different from the other, but because of the marks' similarities, believes that the goods or services bearing the later mark come from the same undertaking or from an economically linked undertaking.⁹⁴ For example, they conclude that the later mark is another brand of the owner of the earlier mark because they share a common element.⁹⁵ In *L.A. Sugar Limited v By Back Beat Inc*,⁹⁶ Mr Iain Purvis Q.C., as the Appointed Person, identified a non-exhaustive list of situations in which the average consumer may be expected to reach such a conclusion, noting that these tend to fall into one or more of three categories:⁹⁷

- “(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements

⁹⁰ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

⁹¹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

⁹² See paragraph 33 of the Appointed Person's decision in Case No. O/049/17, (*Rochester Trade Mark*).

⁹³ *Liverpool Gin Distillery* at [33].

⁹⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, paragraph 10

⁹⁵ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraphs 16-17

⁹⁶ *Ibid.*

⁹⁷ In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added at [12] that it is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

94. I have found that the competing services are identical. The selection process for those services is not overly scrutinised, resulting in a relatively low level of attention. Although visual selection is likely to be the primary means by which consumers encounter the marks, aural selection may nevertheless play a secondary role.

95. The elements LOK'N and LOCK N are visually very highly similar and aurally identical. Taking account of the differences between the marks as a whole, I consider them to be visually similar to a between medium and high degree, aurally similar to a medium degree, and conceptually highly similar.

96. In assessing the likelihood of confusion, I also take into account the distinctiveness of the earlier mark. I have found that the mark is inherently distinctive to between a low and medium degree. In this regard, it is worth noting that even a mark of low distinctive character may support a finding of likelihood of confusion, and that disproportionate emphasis should not be placed on the weak distinctive character of an earlier mark when assessing similarity and confusion, as confirmed by the CJEU in *L'Oréal SA v OHIM* (Case C-235/05 P) at [42] and [45]. The CJEU stated:

"45. [...] The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders."

97. However, based on the evidence of use, I have found that the distinctiveness of the mark has been enhanced to a high degree.

98. Visually, the competing verbal elements share an almost identical structure at the beginning, this is because the presence or absence of an apostrophe before the letter N is likely to go unnoticed; additionally, LOK would be perceived as the ordinary word LOCK regardless of spelling (a point not contested by the Applicant and, indeed, one it advances in its submissions), therefore the inclusion or omission of the letter C is likely to fall victim to imperfect recollection. Accordingly, notwithstanding the visual differences between LOK'N and LOCK N, consumers may, on a quick visual scan, “see what they expect to see,”⁹⁸ and mistake LOCK N for LOK'N. This is particularly so given the low level of attention, the identity of the services, and the fact that both elements will be understood as conveying the same concept.

99. As the beginnings of marks tend to make a stronger impression than their endings,⁹⁹ and attract greater consumer attention, the similarity between the initial elements LOK'N and LOCK N provides the prevailing anchor for the visual, aural and conceptual similarity between the marks.

100. Taking account of all relevant factors, I am satisfied that a significant proportion of the average consumer would be confused as to the commercial origin of the services.

101. However, even allowing for imperfect recollection, I consider that the visual and aural differences between the marks arising from the words STORE and GO are sufficient to avoid a likelihood of direct confusion.

102. I find that a significant proportion of the average consumer would nonetheless be indirectly confused as to the commercial origin of the services. The marks share a common element which is conceptually and aurally identical and visually very highly similar. Notwithstanding the slight visual differences between LOK'N and LOCK N, I bear in mind that indirect confusion can arise not only where the common element is identical but also where it is only similar.¹⁰⁰

⁹⁸ *Kennedy Fried Chicken* (BL O/227/04 at [18])

⁹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

¹⁰⁰ See: *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch); *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271).

103. The overall differences between the marks are not sufficient to outweigh the impact of that shared element in any event, and this is all the more so given the high degree of enhanced distinctive character of the earlier mark.

104. The Applicant submits that the average consumer is likely to perceive the verbs STORE and GO (when preceded by the word LOCK, “*howsoever presented*”) as “*emphasis[ing] the utility of the storage services*”.¹⁰¹ By this, I understand the Applicant to mean that STORE and GO are functional descriptors that highlight different aspects of the same storage service; I consider this to be a fair point, and one that, to me, actually points to brand variation. In my view, the average consumer is likely to recognise the commonality between the marks and to perceive the differences (in particular STORE versus GO, and the additional device elements in the contested mark) as denoting a variation within the same brand, rather than as indicating a different commercial origin.

105. From that perspective, the average consumer is likely to perceive STORE and GO as operating as functional or descriptive signposts, and to perceive the contested mark as a logical variant of the Opponent’s offering; for example, GO would denote a more immediate, short-term, or fast-access storage option. This interpretation is consistent with the Opponent’s evidence that consumers may seek storage for short periods or for relatively small quantities of belongings. In such circumstances, the average consumer may reasonably regard the contested mark as an ‘express’ variant of the core LOK’N STORE service offering and would be indirectly confused as a result.

OUTCOME of the claim under section 5(2)(b)

106. The opposition based upon section 5(2)(b) of the Act is successful.

¹⁰¹ Applicant’s submissions in lieu, at [20].

Claim under section 5(3)

Legislation and Case Law

107. Sections 5(3) and 5(3A) of the Act state:

“5(3) A trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

“5(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

108. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case C-252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C-383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oreal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it; *L'Oreal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any

financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

109. The conditions of section 5(3) are cumulative. Firstly, the Opponent must show that the earlier marks and the Applicant's mark are similar. Secondly, the Opponent must show that the earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the earlier mark being brought to mind by the later mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the three types of damage will occur. It is unnecessary for the purposes of section 5(3) that the services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks. These conditions are addressed in turn below. The relevant date for the assessment under section 5(3) is the filing date of the application at issue, being 18 April 2023.

Similarity of the marks

110. I have found the marks to be similar for the reasons given above.

Reputation

111. I have found that the Opponent has made genuine use of the earlier mark relied on in respect of the following Class 39 services: "*storage services; rental of storage space; rental of secure storage facilities.*" These services are the services for which the Opponent claims its earlier mark has a reputation.

112. I bear in mind the guidance of the CJEU in *General Motors*, Case C-375/97 (in particular [25] – [28] of the judgement). Whilst enhanced distinctiveness and reputation are different, the factors relevant to both assessments are the same. Taking those

factors into account, I consider that the Opponent has a relatively strong reputation in the UK for the relevant services. By this, I mean that the evidence demonstrates a proven and significant level of recognition, placing it above what would be regarded as average. However, it does not reach the uppermost level of reputation; it falls short of being characterised as famous.

Link

113. My assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. Those factors, as identified in *Intel*, are set out below, and I shall address them in turn:

The degree of similarity between the conflicting marks.

114. I apply the same findings as set out at paragraphs 65 to 71 above.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

115. The services in issue are identical. I apply the same findings in relation to the relevant public and purchasing process as set out above.

The strength of the earlier mark's reputation

116. I have assessed this as relatively strong.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

117. The earlier mark has a low to medium degree of inherent distinctiveness in relation to the services for which it has acquired a reputation, but the mark had become highly distinctive through use by the relevant date.

Whether there is a likelihood of confusion

118. Although a finding of a link does not depend on the existence of confusion – since it is sufficient that the later mark merely brings the earlier mark to mind – the CJEU

confirmed in *Intel* that a link would be “necessarily established when there is a likelihood of confusion”.¹⁰²

119. I have found that there is a likelihood of confusion.

Conclusion on link

120. Taking into account all of the above factors, particularly: the strength of the Opponent’s reputation; the identical services; and the similarity of the marks (bearing in mind that the differences between the marks are not sufficient to outweigh the impact of their shared element), I consider that a link will be made in the mind of a significant proportion of the relevant public.

Damage

121. Having established that a link exists, I must now consider whether any of the pleaded types of damage will arise. I note that establishing any one of the three is sufficient.

Unfair advantage

122. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

¹⁰² *Ibid.*, at [57].

123. While the Opponent has frequently used its mark in a particular colour presentation, the evidence also shows use of the mark in word-only form. The reputation established by the evidence is not confined to the colour presentation in which the mark has often been encountered.

124. The competing marks cover identical services, and they share a high degree of visual similarity and aural identity when their common element is compared. Despite their differences, they also convey a highly similar conceptual message. Taken together, these factors would give rise to an immediate sense of familiarity for the average consumer, leading them to believe that an economic connection exists between the parties. To the extent that the relevant public would believe that the Applicant's services are those of the Opponent, there would clearly be unfair advantage.

125. The Opponents evidence demonstrates that it is one of the largest operators in the self-storage industry and invests substantial amounts in growing and promoting its business. It is therefore apparent that there is potential for the Applicant to gain an unfair advantage by exploiting the attractive force of the Opponent's reputation in its mark, without making any corresponding investment, thereby securing a commercial benefit that would not have arisen absent that reputation. On this basis, I consider it likely that the Applicant's mark would take unfair advantage of the reputation of the Opponent's earlier registration.

126. As I have found there to be unfair advantage, I do not need to consider the other pleaded heads of damage.

OUTCOME of the claim under section 5(3)

127. The opposition based upon section 5(3) of the Act succeeds.

CONCLUSION

128. The opposition is successful and, subject to any successful appeal, the application is refused.

COSTS

129. The Opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the Opponent the sum of **£2,300**, calculated as follows:

Preparing a notice of opposition and considering the Applicant's counterstatement	£450
Preparing and filing evidence	£1,200
Written submissions in lieu	£450
Official fee	£200
TOTAL	£2,300

130. I therefore order Bux & Co. Ltd to pay Lok'n Store Limited the sum of **£2,300** which should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 7th day of May 2026

Daniela Ferrari

For the Registrar